



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

COPY MAILED

AUG 31 2005

OFFICE OF PETITIONS

In re Application of :
Sanford D. Markowitz :
Application No. 10/649,591 : ON PETITION
Filed: August 26, 2003 :
Attorney Docket No. CWRU-P03-003 :

This is a decision on the petition filed August 10, 2005 (certificate of mailing dated August 8, 2005), requesting that the above-identified application retain the presently accorded a filing date of August 26, 2003, with page 1 of the specification, as part of the original disclosure.

On August 26, 2003, the above-identified application was filed. On June 8, 2005, the Office of Initial Patent Examination mailed a "Notice of Omitted Items of Nonprovisional Application" (the "Notice"), stating that the application had been accorded a filing date of August 26, 2003, however, page 1 of the specification appeared to have been omitted. The Notice allowed a non-extendable two-month period for reply beginning from the mailing date of the Notice.

In response, on August 10, 2005, applicants filed the present petition and a copy of a postcard showing that, among other items, 74 pages of specification, including claims and abstract, were received on August 26, 2003. The postcard did not contain an Office date-stamp, however, and cannot be used a prima facie evidence that page 1 of the specification was present on August 26, 2003. In the alternative, petitioner argues that a statement incorporating by reference the entire disclosure of a prior filed application was present on August 26, 2003.

The Notice permits applicant to either: (1) promptly establish prior receipt in the Office of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the Office with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such omitted items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h) requesting the later filing date within two months of the date of the Notice (37 CFR 1.181(f)).

An applicant may incorporate by reference the prior application by including in the application-as-filed, a statement that such specifically enumerated prior application or applications are hereby incorporated by reference. The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the divisional application to include any subject matter in such prior application(s), without the need for a petition. See MPEP 201.06(c).

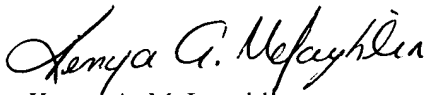
In view of the incorporation by reference of the prior application, page 1 of the specification is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 26, 2003, using only the application papers present on filing. The copy of page 1 of the specification will not be processed for examination, but will be kept in the application file.

The petition fee of \$400.00 will not be refunded as this petition was necessitated by the applicant's filing error, rather than an error on the part of the Office.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 26, 2003.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions